The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001139768 in view of JP 01229064 A.

Rejection is maintained for reason of record with following response.

Applicant has repeated the same argument submitted on April 30, 2009 which does not have any probative value since it does not address the following issue raised by the examiner in the office action mailed on June 8, 2009.

The instant claim 1 recites that Mw of the phenolic novolak resin is 3700 or less, and the instantly recited amounts of the wollastonite and glass fibers are based on said phenolic novolak resin with Mw of 3700 or less. Thus, for example, choosing following components fall within the scope of JP'768 would meet the instant amounts (note that the total amount below is 100 wt%. The instant claims do not recite wt%, but "parts by mass" and "comprising", and thus the total amount of the instantly recited mandatory components can be any wt% below 100 wt%.).

10 wt% of a phenol resin (a) with Mw of 50000 or more,

10 wt% of a phenol resin (a) with Mw of 50000 or less,

5 wt% of hexamethylenetetramine,

5 wt% of clay,

60 wt% of wollastonite and

10 wt% of glass fiber.

Thus, the amount of the wollastonite would be 600 parts by mass based on 100 parts by mass of phenol resin (a) with Mw of 50000 or less, and that of the glass fiber would be 100 parts by mass based on 100 parts by mass of phenol resin (a) with Mw of 50000 or less assuming same specific gravity (Said total parts by mass would go up or down when specific gravity of wollastonite and glass fiber is different from that of the resin). Thus, the total would be 600 parts by mass contrary to applicant's assertion. Note that the phenol resin (a) with Mw of 50000 or more, hexamethylene tetramine and clay (which is not fibrous filler) are not used in the calculation since they belong to other components permitted under the recited "comprising".

Furthermore, the recitation of "consisting essentially of" alone cannot overcome the rejection based on the art reciting "comprising". See ***In re De Lajarte***, 337 F2d 870, 143 USPQ 256 (CCPA, 1964); When applicant contends that modifying components in the reference composition are excluded by the recitation of "consisting essentially of", applicant has the burden of showing the basic and novel characteristics of his composition – i.e. a showing that the introduction of these components would materially change characteristics of applicant's invention.

As a matter of fact, Applicant's own example 4 contains other components such as hexamethylenetetramine taught by JP'768 and other filler such as carbon black (JP'768 teaches clay) and a comparative example must be based on the closest prior art and not on applicant's own choice. Comparative example 3 does not contain wollastonite taught by JP'768 and thus any comparison with respect to said comparative

example 3 has no probative value. The examiner does not see any unexpected result based on the instant claim contrary to applicant's assertion. Even if given a full consideration to said example 4, scope of claim is broader than actual showing.

Claims 1-4, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 01229064 A in view of JP 2001139768.

Rejection is maintained for reason of record with above response.

Claim 12 reciting "consisting of" is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tae H Yoon/
Primary Examiner
Art Unit 1796

THY/October 17, 2009